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REMARKS

Originally filed claims 17 –20 and newly filed claims 21 – 23 are pending. Applicants request reconsideration in light of the following amendments and remarks.

Independent claim 17 has been amended to recite, in part, an apparatus where the first and second feeders are adapted to move first and second webs along separate paths to the cutter. The web handling apparatus is adapted to receive the first and second webs from the first and second feeders. The web handling apparatus is also adapted to position the first and second webs of laminated, tabbed roofing shingle material in a stacked relationship prior to the cutter such that second web is stacked below the first web.

New claims 21 – 23 have been added to recite further embodiments of the present invention. Support for these additional claims is found in the specification and drawings. No new matter is being introduced.

Claim 21 further describes a further embodiment where the web handling apparatus includes at least one means for inverting at least one of the webs so that the shingles produced from the webs are packaged face to-face/back-to-back in a bundle of shingles.

Claim 22 further describes a further embodiment where the controller is adapted for receiving at least one signal from each location sensor. The controller compares the signals received with a predetermined program and determines at least one predetermined measured parameter of the distinct portion. The controller also determines the location of the distinct portion and sends signals to the at least first and second feeders to vary the speed of at least one of the first or second feeders, whereby the end cuts are positioned at the predetermined locations relative to the distinct portion.

Claim 23 also describes a further embodiment where the controller comprises at least one microprocessor.

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Favorable reconsideration is respectfully requested in light of the following remarks. Applicants request withdrawal of the outstanding objections and rejections, and allowance of the claims.

Rejection of claims 17 - 20 under 35 U.S.C. 102 (b), or, in the alternative 103(a)

In the outstanding office action, the Examiner rejected claims 17 – 20 under 35 U.S.C. 102 (b), or, in the alternative 103(a) as being unpatentable over the Lamb US Pat. No. 5,102,487 reference, in view of the Byrt et al. US Patent No. 4,267,752. Applicants contend that all the claims are patentable over these references, and request withdrawal of the rejection under 35 U.S.C. 102 (b), or, in the alternative 103(a).

It is respectfully submitted that the Office Action does not meet the criteria for establishing a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the applied reference must teach or suggest all the claim limitations. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Further, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See MPEP §2143.

With respect to the first criterion, there is no motivation to modify the Lamb US Pat. No. 5,102,487 reference with the cutting apparatus for continuous webs of the Byrt et al. US Patent No. 4,267,752 to meet the claimed invention. Independent claim 17 has been amended to recite, in part, that the first and second feeders are adapted to move first and second webs along separate paths to the cutter. The web

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handling apparatus is adapted to receive the first and second webs from the first and second webs. The web handling apparatus is also adapted to position the first and second webs of laminated, tabbed roofing shingle material in a stacked relationship prior to the cutter, such that second web is stacked below the first web.

In contrast, the Lamb reference teaches away from the present invention by requiring that the shingle be cut before being stacked. The Lamb reference states at column 4, lines 47 – 51, that

“After discrete shingles are formed, they can be processed with commonly used apparatus for handling such shingles, such as shingle stacker 38 to form stacks of shingles 40, and bundle packager 42 to form shingle bundles 44.” (Emphasis added).

Thus, the Lamb reference teaches stacking the shingles after the individual shingles are cut into discrete shingles. In contrast, the present invention has feeders that allow the first and second webs to be formed into stacks of “shingle web material” before the material is cut into individual shingles. Therefore, the Lamb reference does not anticipate or make obvious Applicants' invention as defined in claim 17.

Further, the Byrt et al. reference fails to supply any of the deficiencies of the Lamb reference. Rather, the Byrt et al. reference describes a cutting apparatus for sheets of paper at regular intervals. (See column 2, lines 32 – 33). Combining the appropriate parts of the Lamb and Byrt et al. references, one obtains an apparatus that cuts, and then stacks material. Rather, the cited references teach away from the present invention by requiring that the shingles or other materials be cut before being stacked and formed into a bundle. Further, neither Lamb et al. nor Byrt et al. teach or suggest a controller adapted to control the location of the cutting, based on the sensed locations of the distinct portions of the multiple stacked webs, so that the end cuts of the separate roofing shingles are positioned at predetermined locations relative to the distinct portions as recited in amended Claim 17. Therefore, Lamb

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and Byrt et al. in combination do not teach or suggest the invention as recited in Applicants' amended Claim 17.

Since independent Claim 17 has been shown to be patentable over the applied references, at least for this reason, claims 18 - 23 are also patentable over those references.

Further, neither Lamb et al. nor Byrt et al. teaches or suggests including distance measuring devices to measure the lengths of the distinct portions, as recited in Claim 20. At least for this reason, Claim 20 is also patentable over Lamb and Byrt et al.

In addition, the new claim 21 describes a specific embodiment of the present inventive apparatus where the web handling apparatus includes at least one means for inverting at least one of the webs so that the shingles produced from the webs are packaged face to-face/back-to-back in a bundle of shingles. This is not shown in the references, and therefore claim 21 is also patentable over Lamb and Byrt et al.

Also, the new claim 22 describes a specific embodiment of the present inventive apparatus where the controller is adapted for receiving at least one signal from each location sensor, comparing the signals received with a predetermined program, and determining at least one predetermined measured parameter of the distinct portion. The controller also determines the location of the distinct portion and sends signals to the at least first and second feeders to vary the speed of at least one of the first or second feeders, whereby the end cuts are positioned at the predetermined locations relative to the distinct portion. This is not shown in the references, and therefore claim 22 is also patentable over Lamb and Byrt et al.

Finally, the new claim 23 describes a specific embodiment of the present inventive apparatus where the controller comprises at least one microprocessor. This is not shown in the references, and therefore, claim 23 is also patentable over Lamb and Byrt et al.

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In view of the above amendments and remarks, Applicants have shown that the claims 17 - 23 are in proper form for allowance, and the invention, as defined in these claims are neither disclosed nor suggested by the references of record. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of record, and allowance of all claims.

If any questions should arise with respect to the above Remarks, or if the Examiner has any comments or suggestions to place the claims in better condition for allowance, it is requested that the Examiner contact Applicants' attorney at the number listed herein.